No. 20267

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

SANTA ANITA MFG. CORP., a California corporation,
Appellant,

vs.

MAX J. LUGASH and MAXON INDUSTRIES, INC., a California corporation,
Appellee-Cross Appellant,

vs.

SANTA ANITA MFG. CORP., a California corporation,
Cross Appellee.

APPELLANTS' OPENING BRIEF.

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APPELLANTS' OPENING BRIEF.

JURISDICTION.

This is an appeal by defendant from portions of a final judgment granted by the United States District Court, for the Southern District of California, Central Division, holding claims 1, 2, 4, 8, 9 and 11 of Patent No. 2,837,227 valid and infringed and denying defendant's counterclaim for false marking (Vol. I, pp. 676-677). Jurisdiction of the trial court arose under the provisions of 28 U.S.C. §§1338(a) and 2201 and the patent laws of the United States. Jurisdiction to review the District Court's judgment by this court is conferred by 28 U.S.C. §1291.

STATEMENT OF THE CASE.

A. The Parties.

Appellant, Santa Anita Mfg. Corporation (the defendant below) is a California corporation having a regular and established place of business in Temple City, California where it has manufactured and sold load elevators for trucks known as the "Folda-Lift" hydraulic loaders.

Appellee, Max J. Lugash (one of two plaintiffs below) is an individual residing in California and the patentee of United States Letters Patents Nos. 2,837,227 entitled "Load Elevator for Motor Trucks" and 2,989,-196 entitled "Hydraulic Hoist for Vehicles."*

Appellee, Maxon Industries, Inc. is a California corporation which is the owner of Lugash patents '227 and '196 and manufacturers and sells truck loaders known as "Tuk-A-Way" loaders.

B. The Controversy Raised by the Pleadings.

Defendant was charged with infringement of both Lugash patents '227 and '196 by a Complaint filed by the patentee (Vol. I, pp. 2-4). Defendant answered denying validity and infringement of the patents, asserted affirmative defenses and counterclaimed for a declaration of patent invalidity and non-infringement of both patents (Vol. I, pp. 5-13) to which the patentee replied (Vol. I, pp. 14-15). Maxon Industries Inc., which thereafter became and is now the owner of the patents in suit, was joined as a party plaintiff without prejudice to proceedings already had (Vol. I, pp. 185-187).

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*Patents Nos. 2,837,227 and 2,989,196 will hereafter be identified by '227 and '196, respectively. Appellant will hereafter be referred to as defendant.

The pre-trial conference order placed in issue the validity and infringement of claims 1, 2, 4, 8, 9 and 11 of patent '227 and claims 1, 2, 4, 5 and 6 of patent '196 (Vol. I, pp. 339-349, 220, 330).

Defendant brought a motion to add a count for false marking during trial (which was granted) and the pleadings were amended to include such count based upon evidence adduced during trial (Vol. I, pp. 558-560).

The trial court found patent '227 to be valid and infringed by defendant's "Folda-Lift" loaders [Concl. of Law B, C and E, Vol. I, p. 673]; found patent '196 to be invalid [Concl. of Law G, Vol I, p. 674, not involved in this appeal]; and concluded that plaintiffs had not been guilty of false marking under the law [Concl. of Law I, Vol. I, p. 674]. This appeal seeks a reversal of the trial court holdings that Lagash '227 is valid and infringed and that plaintiffs were not guilty of false marking under the law.

C. The Probable Invalidity of Lugash '227 Indicated at the End of Trial.

Defendant's witnesses included Mr. Vogel, an engineer, president of defendant and **admittedly** a man skilled in the art (Vol. III, p. 354) and Mr. Gabriel, defendant's patent expert and a man with extensive prior experience in the truck loader art (Vol. III, pp. 622-623). Mr. Gabriel qualified as one skilled in the art and he so considered himself (Vol. III, p. 761).

It is defendant's contention that none of plaintiffs' witnesses qualified as being a man skilled in the art. Mr. Comstock (plaintiffs' patent expert witness) had "no specific experience" with power operated loaders of

the type discussed in this law suit prior to being called into the case (Vol. III, p. 272).

By stipulation and order of the court the narrative statements of patent expert testimony filed prior to trial were admitted into evidence as though they were orally presented at trial, subject to cross-examination (Vol. III, pp. 748-753).*

Toward the end of defendant's case after the trial court had heard Messrs. Vogel and Gabriel testify as to the prior art and what it taught to one skilled in the art, the court expressed its doubt about the validity of the two patents in suit (Vol. III, p. 829). After hearing the plaintiffs' rebuttal case, the trial court stated its first impressions on the '227 patent:

> ". . . my first impression is that the plaintiff has a real row to hoe on the validity in view of this prior art." (Vol. III, p. 902).
>
> ". . . it is very questionable in my mind that it is valid, in view of the prior art." (Vol. III, p. 904).
>
> "But I am also inclined to decide now that it is invalid." (Vol. III, p. 905).

What caused the trial court to change its mind? It is submitted that the Memorandum Opinion, the Findings and Conclusions show that the trial court was confused, misunderstood and misapplied the rule of the *Huston v. Buckeye* case,[1] ignored well-established rules of this Court,[2] and failed to apply statutory standards of patentability.

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*Plaintiffs' statement appears at Vol. I, pp. 188-219; defendant's statement appears at Vol. I, pp. 222-317.

[1]Page 30 of this brief.

[2]Page 34 of this brief.

THE LUGASH '227 PATENT IN SUIT.

Patent '227, which issued June 3, 1958 to Max J. Lugash, relates to a load elevator for use in raising or lowering loads between ground level and the truck bed of a motor truck.

In the appended representation of the Lugash '227 patent drawings (App. C, p. 1) the patented loader includes: a loading platform 43 (blue), a pair of parallel rule linkage systems 42, 44 (green; one pair at each side of the platform), hinged connections 47, 48 between the linkage systems and platform provided by support member 50 (yellow), stop means 53 (red) to support the platform in load carrying position and power means 32 (brown) to lift the platform or to allow it to descend [See: Find. of Fact 7, Vol. I, p. 664].

The lifting arms 42, 44 are hinged by bolts 47 and 48 to the platform support member 50 between pairs of flanges 49, 49 carried by the front face of the support member or "angle iron" 50 [Ex. 1, Col. 3, lines 14-17]. Inwardly of flanges 49, 49 there are two more flanges 51, 51 on member 50 also receiving the hinge bolts 48, 48. The platform (bracket arms 52, 52) is thereby pivotally mounted or hinged by the hinge bolts 48, 48 (between flanges 49 and 51) to support member 50 [Ex. 1, Col. 3, lines 43-44].

Ledge element 53 (red) **prevents** pivotal movement of the platform arms in a clockwise direction beyond a horizontal position, but **permits** manual pivoting of the platform in a counter-clockwise direction about the hinge bolts 48, 48 until it rests on cross member 56 [Ex. 1, Col. 3, lines 44-65].

The Lugash '227 file history discloses that the original broad claims directed to a power operated parallelo-

gram lifting arm loader were rejected on old prior art truck loader patents [Ex. A, p. 17]. The single feature of Lugush '227 not found in the cited art and the only feature alleged by the patentee to be novel (during proceedings before the Patent Office) was that the '227 platform can be manually moved or pivoted back on hinge bolts 48 at the discretion of the operator into an inverted, out-of-the-way position beneath the truck bed.

> ". . . the device when folded up . . ., is completely out of the way and thus permits the vehicle to be backed up to a loading dock." [Ex. A, p. 23].

It is this folding which caused the issuance of the Lugash '227 patent [Ex. A, pp. 23-24].

> "It is crystal-clear that after the first rejection, Scoggin relied entirely upon the sealing arrangement as the exclusive patentable difference in his combination. It is likewise clear that it was on that feature that the Examiner allowed the claims."
>
> *Graham v. John Deere Company of Kansas City,* ..... U.S. ....., 86 S. Ct. 684, 701 (Feb. 21, 1966).

Plaintiffs are not now free to assert a broader view of Lugash '227 beyond this single concept of manually pivoting or moving the platform element on its hinge bolts back over the lifting arms to allow its placement in an out-of-the-way position.

> "Here, the patentee obtained his patent only by accepting the limitations imposed by the Examiner. The claims were carefully drafted to reflect these limitations and Cook Chemical is not now free to

assert a broader view of Scoggin's invention. The subject matter as a whole reduces, then, to the distinguishing features clearly incorporated into the claims."

Graham v. John Deere Company of Kansas City, supra, 86 S. Ct. at 702.

The subject matter of Lugash '227, as in the *Graham* case, *supra,* as a whole, reduces to the single feature of permitting inversion of the platform. Defendant contends that this "distinguishing feature" is **found in the non-cited art relied upon at trial** (particularly Narvestad, App. C, p. 2) and that Lugash '227 merely suggests an asserted new use (or non-use) for the identical, old truck loader apparatus disclosed in the expired Novotney '403 patent (App. C, p. 3) in the same manner to obtain the same results as suggested by the prior art (such as Narvestad).

WHAT LUGASH '227 DID NOT INVENT.

This Court and the Supreme Court have repeatedly stated that a patent cannot claim and withdraw from the public that which is public knowledge. But that is exactly what the plaintiffs' patent wrongfully attempts to do.

This Court can take judicial notice that Lugash did not invent a truck, nor a power operated loading device to be employed with the truck; these have been in the public domain for fifty years. Can plaintiffs contend that Lugash was the first to hinge a loader platform into a stored out-of-the-way position to permit the truck to be backed up to a loading dock for ready loading? No, that has been common practice for many years as shown by any of the prior Narvestad, Peters or Jester

patents in which the loader platforms are pivotable about hinge means in identical manner to be inverted over the lifting arms [Find. of Fact 19, Vol. I, p. 664] and in the prior commercially successful Daybrook "DA" and Anthony "Drop-Leaf" loaders where the loader platforms are hinged down into an out-of-the-way position [Exs. E-G, AD] allowing dock loading.

The parallel linkage lifting arms, the brackets and support members, the hinge pins which pivotally connect the platform to the support member were not invented by Lugash but are clearly shown in the prior art [Exs. C, D, E-G and AD] including the expired patent to Novotney '403 as will be discussed in detail hereinafter.

Detailed discussion of these prior art patents on pages 20 to 23 of this brief and defendant's trial Exhibits AM-1 through AM-6 convincingly show that **every element for the same purpose was present in the prior art devices.** The patent is invalid since:

> ". . . it consists of no more that a combination of ideas which are drawn from the existing fund of public knowledge and which produces results that would be expected by one skilled in the art."
>
> *Griffith Rubber Mills v. Hoffar,* 313 F. 2d 1, 3 (C.A.9).

Plaintiffs cannot challenge the fact that all of the elements are old [Find. of Fact 8, Vol. I, p. 664]. Plaintiffs will be forced to admit that the purported novelty lies only in the use of the hinge connection and stop means:

> "permitting inversion of the platform." [Ex. 1, claim 8, lines 42-45].

The discretionary pivoting of a hinged platform, trap door or any other element on an old hinge is not an invention conforming to the statutory requirements of novelty, utility and unobviousness, ". . . each of which must be satisfied" (*Graham v. John Deere of Kansas City, supra,* 86 S. Ct. 694).

To hold that the Lugash patent is valid, this Court would have to state that a patent can monopolize the discretion of a man in moving an old member on an old hinge (Novotney '403) in a manner taught by the prior art (Narvestad).

Note that the trial court concluded that:

> ". . . It is mechanically *possible* to invert the platform in said Novotney device." [Find. of Fact 16, Vol. I, p. 666].

Patentability cannot be based upon the mere recognition of an alleged new function (folding) for an old device (Novotney '403) even though the prior inventor may not have realized his apparatus could be used in such a manner (*Mathews Conveyor Co. v. Palmer-Bee Co.,* 135 F. 2d 73, 89 (6th Cir. 1943)).

Appellant is confident that this Court will be compelled to hold invalid a patent which attempts to prevent a person from moving an old hinged member of an old structure which is mechanically or manually capable of being moved. One cannot patent the obvious or preclude the exercise of discretion.

Moreover, to hold Lugash '227 valid, this Court would have to ignore the fact that prior patents, not cited by the Patent Office, actually disclose hinged platforms which are manually pivoted or folded into inverted position to solve the identical problem of dock loading, in the identical way, as in Lugash '227.

The above brief statement of the case emphasizes the pertinency of the following specification of errors and the questions presented to this Court.

SPECIFICATION OF ERRORS.

1. The trial court erred as a matter of law in concluding patentability [Concls. of Law B and C] upon Findings of Fact that Lugash '227 stored the loader platform under the truck bed only "in a more facile and efficient manner" [Find. of Fact 24] and produced merely "significant economies of time and money to users" [Find. of Fact 28] instead of applying the more rigorous requirement of a new, unusual, surprising or unexpected result required of combination claims in *A. & P. Tea Co. v. Supermarket Corp.,* 340 U.S. 147 (1950), a high level of patentability reaffirmed by *Graham v. John Deere Company of Kansas City, supra,* and required for patent validity in *United States v. Adams,* ..... U.S. ....., 86 S. Ct. 708 (Feb. 21, 1966).

2. The trial court erred as a matter of law by relying upon a "presumption" of validity and "makeweight" factors such as commercial success instead of applying the prerequisite test of obviousness in the light of the combined state of the art. Findings 8, 9, 14, 19, 24 to 28 are in error and show that the statutory requirements for patentable invention were not applied. Findings 13A, 18, 24 and 28 are clearly erroneous and contrary to the evidence.

3. The trial court erred as a matter of law by applying improper tests for determining obviousness (*Graham v. John Deere Company of Kansas City, supra*) in failing to properly determine the differences between

Lugash '227 and the combined state of the art, in ignoring the uncontradicted testimony of defendant's technical experts as to the obviousness of Lugash '227 from the combined teachings of the prior art and in giving undue primary consideration to alleged commercial success [Finds. of Fact 8, 9 and 14], supposed absence of commercial success of the prior patented devices [Finds. of Fact 19 and 24] and the length of time the Lugash combination was assertedly overlooked by others [Finds. of Fact 24-28], all of which are at best only secondary considerations or sub-tests. The trial court erred in placing any reliance upon the supposed absence of use of the prior patents [Finds. of Fact 19 and 24] and their alleged long but overlooked availability [Finds. of Fact 24 and 28] since it is irrelevant that no one apparently chose to avail themselves of the knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search (*Graham v. John Deere Company of Kansas City, supra,* 86 S. Ct. 703).

4. The trial court erred as a matter of law in relying upon a presumption of validity for the '227 patent (Vol. I, p. 567, lines 18-19) since any such presumption was overcome by any, or all, of the non-cited prior Narvestad, Peters and Jester patents, all of which disclosed the folding or inverting of a loading platform not found in the art considered by the Patent Office Examiner. A presumption cannot take the place of statutory requirements.

5. The trial court erred in finding a new combination of admittedly old elements [Finds. of Fact 7, 8 and 24] since all the old '227 elements are found in the same cooperative relationships in the prior art (as in

Novotney '403) and it erred as a matter of law [Concls. of Law B and C] in not requiring these old elements to obtain or perform some surprising, unexpected or non-obvious function or result in the combination that they did not perform or obtain out of it, as required by *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545 and *United States v. Adams, supra.*

6. The trial court erred as a matter of law in failing to make any Findings of Fact specifying differences between the claimed subject matter of Lugash '227 and the combined state of the art taken as a whole. Findings of Fact 16 and 17 only allege differences between Lugash '227 and Novotney '403 taken alone (Vol. I, p. 666). Findings of Fact 19-22 only assert differences between Lugash '227 and the similar teachings of Narvestad, Peters and Jester isolated from the other art (Vol. I, pp. 667-668). No Finding of Fact states any differences between the combined teachings of the art [such as Novotney '403 and Narvestad, or Wood '135 and Narvestad, Exs. AM-5 and AM-6] and the claimed subject matter of Lugash '227. The trial court's ultimate conclusions of non-obviousness [Finds. of Fact 13A, 18, 25 and 28] are unsupported and fail to properly advise the Appellate Court of the basis for its decision (*Welsh v. Strolee,* 9th Cir. 1961, 290 F. 2d 509).

7. The trial court erred as a matter of law in failing to find anticipation of the Lugash '227 claimed subject matter in view of Novotney [Find. of Fact 15] because of an erroneous view of the law which led the trial court to conclude that the folding or inverting of the platform was not "inherent" in Novotney [Find. of Fact 17] while at the same time "mechanically possible" [Find. of Fact 16]. There is no evidence to sup-

port the portion of Finding of Fact 16 which states that the folding of the platform possible in Novotney would not produce "substantially the same result as in plaintiffs' patent '227" and the Findings are silent as to why the same result wouldn't be attained.

8. The trial court erred in finding that the Narvestad, Peters and Jester patents disclose a different mode of operation in "inverting of the platform" and do not disclose "any means" whereby the lifting arms and power means can be utilized in storing the loader platform [Finds. of Fact 19, 20 and 21] as allegedly accomplished for the first time in Lugash '227 [Find. of Fact 8]. In each of Lugash '227, Narvestad, Peters and Jester the platform is moved identically, *i.e.*, by manually pivoting the platform over the lifting arms. In Narvestad, Novotney and Jester, lifting arms and associated power means are disclosed which can be employed to raise or lower the platform whether moved into inverted position or not.

9. The trial court erred in failing to find that parallel linkage arms (admitted to be long known in the art) are obvious substitutes for the lever arms employed in Narvestad, Peters or Jester [Finds. of Fact 19 and 22]. Lugash '227 is merely an obvious modification of any of them.

10. The trial court erred in finding that the '227 loaders were the first commercially successful loaders that could be stored in an out-of-the-way position [Finds. of Fact 8 and 24]. The prior Anthony "Drop-Leaf" loader [Ex. AD, Find. of Fact 24] and Daybrook "DA" loader [Ex. E-G, pp. 12-13] were commercially successful and accomplished the same results in positioning the loader platform out-of-the-way for dock load-

ing. The Findings do not state any problem unsolved in the art prior to Lugash '227.

11. The trial court erred in attributing the alleged commercial success of plaintiffs' "Tuk-A-Way" loaders [Exs. 21 and 22, Find. of Fact 9] to Lugash '227. The preferred exemplary embodiments shown in '227 were not a success. It was the loader described and claimed in the invalid '196 patent filed only five months after '227 that attained the sales of Plaintiff's Exhibit 22 and are shown in the "Tuk-A-Way" brochure Exhibit 21. There was no immediate wide adoption by the trade. Less than 100 units per year were sold by plaintiffs from 1957 to 1960. It was only after 1960 and after defendant's sales of the "Folda-Lift" to the trade that plaintiffs' sales increased measurably. Findings of Fact 26 and 28 are in error to the extent that they allegedly import non-obviousness and success of the '227 loader. Defendant's previously successful EB-1500 hydraulic loader is as responsible for defendant's success [Find. of Fact 14] as any other factor.

12. The trial court erred in finding that the defendand infringed Lugash '227 patent by its "simple" and "not major" modification [Find. of Fact 13A] of the existing EB-1500 hydraulic lift gate loader of a type long successful in the art [Finds. of Fact 10 and 11] to incorporate therein the simple and easily accomplished concept of inverting the platform over the lifting arms to place it in an out-of-the-way position, a concept "fully disclosed and dedicated to the public" in each of the Narvestad, Peters and Jester patents (*Graham v. John Deere Company of Kansas City, supra*).

13. The trial court erred [Finds. of Fact 29 and 30 are erroneous] because defendant's "Folda-Lift" loaders

do not employ the mode of operation of Lugash '227 of folding the platform back on the linkage. Defendant's loader platform abuts the hydraulic cylinder which is part of the power means and not the linkage. Also, the parallel rule linkage systems of Lugash '227 are not employed in the ramping type of "Folda-Lift" loaders of defendant which do not maintain the platform level as intended in Lugash [Find. of Fact 22].

14. The trial court erred [Find. of Fact 38] in finding the '196 patent mismarking to be the result of "innocent mistake" and without "intent to defraud" or "deceive" the public.

The fact of mismarking was established during the testimony of Mr. Murray Lugash (Vol. III, pp. 289-319) who stated that he didn't know who determined that the patent numbers went on the non-unitary H-23 Model (Vol. III, p. 307). Plaintiffs presented no other witness who did know why the '196 patent numbers were applied to these loaders. The false marking intent must be presumed until rebutted (*Krieger v. Colby,* 106 F. Supp. 124). The fact of mismarking was uncontradicted and the presumption of intent was not overcome.

SUMMARY.

The file history of the '227 patent [Ex. A] shows that truck loaders having power operated parrallelogram lifting arms connected to a support member to which a loading platform is hinged or pivoted are old (Richards and Ives, Vol. III, p. 639). No new or different construction, function, result or mode of operation was or is claimed for the '227 loader when actually used for loading or unloading a truck (Vol. III, pp. 624, 864). When placed in its stored position the apparatus performs no function (Vol. III, pp. 41 and 633).

The claims of the patent **do not claim an inverted platform,** a loader in stored away position or any manner of moving the platform and/or lifting arms into a stored position. Claim 8 merely specifies a particular stop means (element 53, colored red in Appendix C, p. 1) which permits manual pivoting of the platform on old hinge means in one direction, but prevents it in the other. **The identical construction** and stop means **is found in Novotney** '403 [App. C, p. 3; Exs. AM-1, AM-2], **a prior art patent not found nor considered by the Patent Office** in acting on Lugash '227. The trial court found that it is possible to fold the Novotney platform back over the lifting arms [Find. of Fact 16, Vol. I, p. 666], as is shown in defendant's Exhibits AM-1 and AM-2. Other prior art patents such as any of Narvestad, Peters and Jester also show invertible or foldable platforms.

Lugash '227 thus reduces to merely the manipulation of an old platform about an old hinged connection in an old loader construction to place the platform in an inverted out-of-the-way position. But, such inverting of a loader platform into an out-of-way position is admittedly not new [Find. of Fact 19, Vol. I, p. 667]. For example, it is fully disclosed in the prior Narvestad patent (App. C, p. 2) not considered by the Patent Office. (Note the identity of the objects of Lugash '227 and Narvestad set out in the Appendix).

The Lugash '227 claims read on and attempt to withdraw from the prior art the old loader construction of Novotney '403 (App. C, p. 3) based only on a supposedly new manipulation (folding of the platform) of the old Novotney loader in a manner suggested by Narvestad and found possible in Novotney.

Defendant's technical expert witnesses Vogel and Gabriel testified that had they been presented with the combinations of Narvestad and Novotney (Vogel, Vol. III, pp. 462-463, 485-486; Gabriel, Vol. III, pp. 699-701), or the combination of Wood '135 and Narvestad [Gabriel, Vol. III, pp. 718-724 and Exs. AM-5 and AM-6] in 1957 at the time of the alleged Lugash invention, it would have been obvious to make the '227 combination to provide a parallel arm hydraulic loader with a foldable platform.

Defendant's combination of Wood '135 and Narvestad [Exs. AM-5 and AM-6] was obvious to and actually made by the Patent Office in acting on the second Lugash '196 patent in rejecting the original broad claims [Ex. B, p. 17]. Such combination was never considered by the Patent Office in acting on Lugash '227. It should have been; Lugash '227 issued by inadvertence.

Plaintiffs did not present evidence rebutting the obviousness of Lugash '227 in the light of the combined showings of the prior art patents. Defendant's evidence is uncontradicted. **The trial court** in its Memorandum Opinion and in the Findings of Fact **does not state a single reason why the combinations of the teachings of the prior art patents** relied upon by defendant (such as Novotney '403 in view of Narvestad '529) **do not render the Lugash '227 patented combinations obvious** to one skilled in the art. The trial court's decision and the Findings of Fact are all directed to the sub-tests of commercial success, long felt need and failure of others to commercially succeed with similar loaders in support of non-obviousness of the '227 patent found in Finding of Fact 7 (Vol. I, p. 664).

At the end of the trial, the court expressed its first impressions to hold Lugash '227 invalid. The Memorandum Opinion (Vol. I, pp. 561-573) discloses some of the trial court's thinking in changing to its eventual holding of validity: the folding of the loader platform possible in Novotney '403 was erroneously found not to be "inherent" (Vol. I, pp. 563-564); the non-cited patents including Narvestad, Peters and Jester, though disclosing the folding platform feature of Lugash '227 not found by the Patent Office were somehow not found to overcome the presumption of validity.

Since the hinging movement of the platform into folded position was shown by Novotney, Narvestad, Peters and Jester, plaintiffs were compelled to fall back on another fallacious argument, namely that the prior folded platforms were not raised by power (Comstock, Vol. III, pp. 879-880). This argument fails because:

a. power actuated lifting arms carrying a hinged platform element are very old;

b. the old arms will lift the platform when it is empty, when it is full, when it is painted green, or when it is manually pivoted into a folded position, with no change in construction or mode of operation; and

c. **it is obvious that power driven lifting arms will lift whatever is carried on them.**

Prior patents have shown platforms hinged to lifting arms; it would be inequitable to now preclude the public from manually pivoting a platform if they so desired.

How can this Court hold that a new, non-obvious or unexpected result is attained by using old elements in an old combination, to perform their normal and ex-

pected function? There is no basis in fact and no support in law for Findings of Fact 8, 21, 22, and 23 (Vol. I, pp. 664 and 667).

How has the '227 patent *added* to the sum of useful knowledge in a manner beyond the ordinary exercise of skill in the art? **A prerequisite of patentability is that the subject matter be unobvious** (35 U.S.C. §103). Here we have uncontroverted evidence that it was obvious. Make-weights such as commercial success or added facility do not satisfy statutory requirements.

THE QUESTIONS PRESENTED.

1. Did the trial court err, as a matter of law, in failing to apply the statutory standard of invention required by the *A. & P. Tea Co.* case and reiterated by the recent Supreme Court decisions?
2. Do the claims of Lugash '227 define a patentable invention (conforming to each of the statutory requirements of novelty, utility and non-obviousness) in the light of all prior knowledge and expected skill of men in this art?
3. Do the claims of Lugash '227 define a patentable invention over the showings of Novotney '403, Narvestad '529, Wood '135, Peters '577, Jester '243, and other patents of record herein?
4. Did the trial court err in substituting its own opinion (as to obviousness) for the uncontradicted testimony of experts in this art?
5. Did the trial court err in relying upon a presumption of validity instead of applying the prerequisite statutory tests of invention, repeatedly enunciated by this Court and reiterated recently by the Supreme Court?

6. Is the presumption of validity dissipated when prior patents, not considered by the Patent Office, show the same elements in the same combination for the same purpose?
7. Do the patent statutes contemplate the grant of a patent which would preclude a person from exercising his discretion in operating an old machine mechanically capable of such operation?
8. Can defendant be held to infringe the Lugash patent by employing a construction taught and suggested by expired prior art patents?
9. Can a presumption of intent to mismark, based upon evidence of the established fact that plaintiffs falsely marked their loaders with the '196 patent number, be disregarded without rebuttal?

THE PRESUMPTION OF VALIDITY IS DISSIPATED BY THE PERTINENT PRIOR ART NOT BEFORE THE PATENT OFFICE.

In acting upon the patent application which issued as Lugash patent '227, the Patent Office did not consider pertinent prior art patents including Narvestad 2,680,529, Peters 113,577, Jester 2,033,243, Novotney 2,194,403 and the Wood Patent '135. The normal presumption of validity is therefore overcome pursuant to the many decisions of this Court including

Mettler v. Peabody Engineering Corp., 77 F. 2d 56 (C.A. 9);

McClintock v. Gleason et al., 94 F. 2d 115 (C.A. 9);

Jacuzzi Bros. Inc. v. Berkeley Pump Co., 191 F. 2d 632, 634 and Note 4, 637.

and the Supreme Court in

Graham v. John Deere Company of Kansas City, ... U.S. ....., 86 S. Ct. at 702.

Specific reference is made to those uncited patents because they disclose the "folding up aspect" of the platform—the only feature represented to be novel to the Patent Office [See Ex. A, p. 24; Gabriel, Vol. III, pp. 645 and 698].

But these patents clearly show this "feature" and even the Findings admit that they

> ". . . disclosed the folding of a platform by hinged means to an inverted position over the lifting arms . . ." [Find. of Fact 19, Vol. I, p. 667].

Therefore that which was represented to the Patent Office as being novel **was not novel.** The presumption of validity is completely overthrown. The subject matter of Lugash '227 is but an obvious following of the teachings of the prior art.

Your Honors are requested to look at Exhibit C-4 and Appendix C, page 2, to fully appreciate the pertinency of the uncited patent next discussed in detail.

1. NARVESTAD '529.

This patent discloses a truck loader platform 26 (blue) hinged to lifting arms 20, 21 (green) by hinged connections provided by a platform support member 24 (yellow). Stop means (red), provided by the extreme ends of arms 21 protruding through member 24 support platform 26 in its loading position while the power means 16 (brown) may be employed to raise or allow lowering of the platform. The lifting arms 21, 21 are not parallel linkage systems and the platform

ramps, *i.e.,* slightly changes its angle of disposition, during raising and lowering.

Plaintiffs admit that Lugash **did not invent parallel arms** to hold a platform level as it is raised. This is shown in old patents to Wood '135, Richards '166, and Shadbolt '822 (1896) and in the commercial Daybrook [Ex. E-G] and Anthony [Exs. AC and AD] brochures. **Uncontradicted testimony establishes that it would be obvious to substitute the linkage of the Wood '135 patent for Narvestad's lifting arms** [Vol. III, pp. 671-672 and 718-724, Exs. AM-5 and AM-6].

A prior patent showing "hinge means permitting inversion of the platform" was not before the Patent Office during the prosecution of the Lugash application. Such hinge means, however, are fully disclosed in Novotney as well as in Narvestad, whose platform 26 can be inverted or folded out of the way as shown in Fig. 7 so as to allow dock loading.

2. NOVOTNEY '403.

The Novotney Patent No. 2,194,403 (App. C, p. 3) discloses a truck loader identical to Lugash '227. A platform 9 (blue), is hinged to a pair of parallel rule linkage systems 7, 7′ (green) by a platform support member 8 (yellow). Support member 8 forms the lower vertical links joining lifting arms 7, 7′ and pivotally mounts platform 9 just as the platform support member 50 joins the arms 42, 44 and pivotally mounts platform 43 of Lugash '227. Stop means 11 (red) support the platform in horizontal load carrying position and hydraulic power means including rod 14 and cylinder F (brown) are employed to optionally raise or lower the platform between the ground and truck bed.

Novotney '403 not only discloses the same combination of loader elements operating in identical fashion as Lugash '227 while loading or unloading the truck, but also discloses the identical kind of hinged connections between the lifting arms and loader platform described by Lugash '227. **The Novotney hinge means permits inversion of the platform** and the trial court so found in concluding that "it is mechanically possible to invert the platform in the said Novotney device" [Find. of Fact 16, Vol. I, p. 666]. The lifting arms can be raised or lowered whether the platform is extended or pivoted back over the lifting arms at the discretion of the user.

Similar folding platforms are shown in the non-cited Peters (Australia) patent 113,557 [Ex. C-2] and Jester patent 2,003,243 [Ex. D-4]. The trial court found that these patents "disclosed the folding of a platform by hinged means to an inverted position over the lifting arms" [Find. of Fact 19, Vol. I, p. 667].

The trial court erred in giving significance to the presumption of validity of the Lugash '227 patent in finding validity in its Memorandum Opinion (Vol. I, p. 567, lines 18-19).

> "Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated. Such is the case here."
>
> *Jacuzzi Bros. Inc. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 and Note 4, 637 (9th Cir., 1951).

The trial court has apparently completely **ignored the above rule of law** which this Court has reiterated many times. The trial court recognized that the folding was old in Narvestad, Peters and Jester, but made an error of law in not realizing that, in accordance with the rule, these patents individually or in combination overcame the presumption of validity.

The recent Supreme Court case of *Graham v. John Deere Company of Kansas City,* 86 S. Ct. 684 (1966) is directly applicable to the facts in this case. In the *Graham* case the alleged "distinguishing feature" was a sealing arrangement which was not in the prior art patents before the Patent Office, but was found in an uncited Livingstone patent before the court.

> "Moreover, the space so strongly asserted by Cook Chemical appears quite plainly on the Livingstone device, a reference not cited by the Examiner.
>
> "The substitution of a rib built into a collar likewise presents no patentable difference above the prior art. It was fully disclosed and dedicated to the public in the Livingstone patent."
>
> *Graham v. John Deere Company of Kansas City, supra,* 86 S. Ct. at 702.

The Supreme Court therefor concluded that it would be **obvious** to employ the sealing arrangement taught by the Livingstone device in combination with the other prior art, even though the hold-down cap of Livingstone was applied to a somewhat different device than that employed in the patent in suit. (In Livingstone, the hold-down cap was employed to hold down a spout in a container rather than a sprayer head.) The Supreme

Court considered the prior art as a whole and combined the teachings thereof to demonstrate the obviousness of the patented construction.

This Court must consider the truck loader art as a whole. It is obvious to employ the platform folding arrangement taught by the Narvestad, Peters or Jester patents in combination with the other prior art loaders of Exhibits C and D (such as Novotney '403 or Wood '135) to fold the platform for ease of dock loading (compare the Narvestad and Lugash '227 objects on collapsing and folding the platform, Appendix C, pages 1 and 2).

CLAIMS OF LUGASH '227 DO NOT DEFINE A PATENTABLE INVENTION.

The claims of a patent must particularly and distinctly define the purported invention (35 U.S.C. §112). Let's look at claim 8 of Lugash '227 which the trial court referred to in Finding of Fact 7 as best summarizing the Lugash subject matter. The drawing of the Lugash loader, code colored, appears in Appendix C, page 1. Claim 8 reads as follows:

> "In a load lifting and lowering means attachable to a load carrying vehicle at a point thereon below the vehicle bed,
>
> a **platform** (blue) on which the load is carried,
>
> a **pair of parallel rule linkage systems** (green) disposed one each adjacent each side of said platform, each of said linkage systems having one end thereof attached to the vehicle at a point below the plane of the vehicle bed and the other end thereof connected to said platform,

> the **connections** (yellow) between said linkage systems and said platform including horizontally disposed **hinge means and stop means** (red) effective to **permit said platform to be swung** on said hinge means into superposed position on said linkage systems and **to prevent said platform from being swung** on said hinge means in the opposite direction beyond a position in which said platform extends with the load carrying surface thereof substantially parallel to the plane of the vehicle bed, and **power means** (brown) operable optionally to lift said platform bodily or to allow said platform to descend."

THERE IS NOTHING NEW AND PATENTABLY NOVEL IN THIS COMBINATION. Please look at page 12 of Exhibit E-G, a catalog of Daybrook power gates. These prior art loaders had a loading platform, parallel rule lifting arms, a connection between the arms and the platform including a hinge or pivot, and power means. Note the matter printed at the bottom of page 12, between the diagrams:

> " 'DA' platforms give the advantages of ground to truck bed loading and unloading—yet fold to a straight down position to permit dock operations."

Please note that this Daybrook platform **"folds"** to below the truck bed to **permit dock loading.** Lugash did not invent dock loading.

Can there be invention in providing a stop on a hinged element to prevent the element from swinging

too far? No, because each member of this Court has seen such stops on hinged doors, stopping the door from swinging beyond a desired position while permitting the door to swing in the opposite direction as far as you want.

But now let us look at Exhibit AM-2 where a deadly comparison with Novotney '403 clearly shows **each and every** element of Lugash claims 8, 9 and 11 to be old.

This exhibit speaks for itself. The evidence, including the testimony of Vogel and Gabriel, establishes irrefutably that Novotney is a complete anticipation. (See Vol. III, pp. 484-486, 699-701, 775-781, 842-844).

Similarly Exhibit AM-1 shows that each and every element of claims 1, 2 and 4 of Lugash '227 in the same combination for the same purpose is taught by the expired Novotney '403 patent which is now in the public domain.

It is submitted that the claims of Lugash '227 are invalid since the statutory prerequisites of patentable invention (novelty, utility and lack of obviousness) have not been met.

What is in the public domain can be freely used by all. Foldable loading platforms were old; plaintiff cannot deprive a member of the public of the right to manually pivot an old platform which is capable of pivoting about a hinge or pivot pin.

CLAIMS OF LUGASH '227 ARE INVALID BECAUSE INDEFINITE.

35 U.S.C. §112 requires that a patent include ". . . claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

It is noticeable that the trial court adopted Findings (prepared by plaintiffs) which attribute characteristics of novelty to the Lugash assembly which are **not stated in the claims.**

For example, Finding of Fact 8 states that "power means moves a load platform into and out of a stored position" but that is not in any Lugash claim.

The claims of Lugash '227:

DO NOT REQUIRE that the platform be folded or "swung";

DO NOT SPECIFY when (or in what position) the platform "may" be swung [But in Finding of Fact 6, the trial court stated that the folding takes place at ground level];

DO NOT STATE what is to be done after a platform is "swung" at the operator's discretion;

DO NOT REFER to a swung platform as an element;

DO NOT REFER to movement of a platform into stored position;

DO NOT REQUIRE movement of a platform into position under a truck bed [But Findings of Fact 6 and 22 are based on this false premise]; and

DO NOT STATE that the power means are operable with the platform in a "swung" position.

Therefore what plaintiffs represent as the "novel features" are not defined in the claims. The requirements of 35 U.S.C. §112 have not been complied with, and the claims are **invalid.** The only positive elements specified in the Lugash claims read directly upon the old expired construction shown in Novotney '403.

The Supreme Court has stated:

> "The statutory requirements of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise."
>
> *United Carbon Co. v. Binney & Smith Co.,* 317 U.S. 228, 236.

Plaintiffs will probably try to argue out of this corner by claiming that the platform "may" be swung in their construction and that the power means "may" be operated after the platform is swung. **Similarly,** however, **the platform 9 of Novotney** '403 **"may"** be swung and the power means of Novotney **"may"** be operated after it is swung. The trial court found that such movement is possible.

At all events the claims of Lugash are invalid because they do not point out the alleged (if any) "novel feature." The claims are invalid because they attempt to cover that which is already in the public domain; one cannot get a patent by relying upon semantics or by reading between the lines of a claim. Minor modifications are not the subject of valid patents.

> "A mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitu-

> tion of equivalents, doing substantially the same means with better results, is not such achievement as will sustain a patent."
>
> *Smith v. Nichols,* 88 U.S. 112 at 119

It is submitted that this Court is compelled to hold all of the claims invalid on at least two grounds, namely: (A) lack of invention and (B) failure to comply with 35 USC §112.

Note is here made of an ancillary rule which is applicable where the claims do not specify the purported novelty, namely:

> "Of course, what is not claimed is public property. * * * The public has the undoubted right to use, and it is presumed does use, what is not specifically claimed in a patent."
>
> *Mahn v. Harwood,* 112 U.S. 354 at 361.

An invalid patent cannot be infringed: defendant cannot infringe if he uses what is not claimed.

THE TRIAL COURT WAS CONFUSED AS TO THE LEGAL EFFECT OF THE FOLDING OF THE PLATFORM SHOWN IN NOVOTNEY '403.

The Novotney '403 loader platform can be folded back over the lifting arms without any modification of its construction [Vogel, Vol. III, pp. 484-486; Gabriel, Vol. III, pp. 699-700, 775-781; Exs. AM-1 and AM-2; Find. of Fact 16, Vol. I, p. 666]. However, the trial court required that the inverting of the platform (possible in Novotney) be the "essence of the invention contained therein" before it could be considered "inherent" [Mem-

orandum Opinion, Vol. I, p. 564, lines 9-12; Finds. of Fact 15-17, Vol. I, p. 666]. The Memorandum Opinion and Findings clearly show that the **trial court was confused and misunderstood the rule** stated in *Huston v. Buckeye Bail Corporation,* 107 U.S.P.Q. 138.

The essence of the claim before Judge Cecil in the *Buckeye* case was the "turning" of a fishing "sinker" when resting on the bottom of the sea to expose more of its lower red half and thus notify the fisherman that his sinker is on the bottom (*Houston v. Buckeye, supra* at 140). There was no suggestion of the "turning movement" in the prior art Olson patent, but the court there found that **it could so turn** and was therefore inherent. Judge Cecil correctly stated:

> "If the turning movement was inherent in the Olson patent it can be said to have been taught by and included in the prior art whether claimed by Olson or not. 'An inventor is entitled to all that his patent fairly covers, even though its complete capacity is not recited in the specifications and was unkown to the inventor prior to the patent issuing.' 2nd Syl. Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428."

In the instant case, when the trial court found the folding of the platform to be possible in Novotney '403, he had thereby actually found it to be inherent within the meaning of the *Buckeye* case, *supra.* The trial court was confused.

The trial court erred in believing that it was necessary for Novotney '403 to describe in detail the folding of

the platform and its use. That is not the law. The Novotney platform can be folded, and the Novotney '403 patent **is an anticipation** pursuant to numerous authorities:

> "An old mechanism fully capable of a use not then observed, anticipates a later patent for the application of that means to the new use. Patentability cannot rest on the observation in a given device of a usefulness not before noticed; and the fact that a party did not in fact use his mechanism for a particular purpose, or even that he did not foresee that such purpose would be a useful one, is not material. William B. Mershon & Co. v. Bay City Box & Lumber Co., C.C. Mich., 189 F. 741. Discovery of new uses for, or newly observed functions of a device, well known in the mechanical or structural arts, is not patentable invention; Grand Rapids Refrigerator Co. v. Stevens et al., 6 Cir., 27 F.2d 243; and the use for which an apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent. Dwight & Lloyd Sintering Co. v. Greenawalt, 2 Cir., 27 F.2d 823."
>
> *Mathews Conveyer Co. v. Palmer-Bee Co.,* 135 F.2d 73, 89 (6th Cir., 1943).

> ". . . Pipkin found latent qualities in an old discovery and adopted it to a useful end. But that did not advance the frontiers of science in this narrow field so as to satisfy the exacting standards of our patent system. Where there has been use of an article or where the method of its manufacture is known, more than a new advantage of the product must be discovered in order to claim in-

vention. See *DeForest Radio Co. v. General Electric Co.*, 283 U.S. 664, 682. It is not invention to perceive that the product which others had discovered had qualities they failed to detect. See *Corona Cord Tire Co. v. Dovan Chemical Corp.*, 276 U.S. 358, 369."

General Electric Co. v. Jewel Co., 326 U.S. 242, 247 (1945).

". . . But the observation of a new use in a prior patented device is not patentable; and the mere fact that the inventor did not use his device for that purpose or did not foresee that the purpose might be useful is immaterial."

Triangle Conduit & Cable Co., Inc. v. National Electric Products Corporation, 149 F. 2d 87, 90 (3rd Cir., 1945).

Lugash '227 does not disclose anything new over the disclosure of Novotney '403 and is invalid. A contrary finding withdraws the Novotney '403 apparatus from the public domain and gives an undeserved monopoly to plaintiffs. The Novotney '403 loader is an anticipation of Lugash '227 because the platform can be folded over the lifting arms and because it has the specific construction claimed by Lugash [Exs. AM-1, AM-2]. Lugash '227 cannot be valid. The trial court's holding of validity must be reversed.

A contrary conclusion would award the plaintiffs with a monopoly extending until 1975 over a loader construction disclosed by Novotney '403 in 1940 and dedicated to the public in 1957.

IT IS NOT PATENTABLE INVENTION TO DO WHAT IS SUGGESTED BY THE PRIOR ART.

Lugash '227 contributes nothing to the fund of public knowledge beyond that already disclosed in the prior art (such as the combination of the teachings of the Novotney '403 and Narvestad patents).

The provision of parallelogram linkages in a load elevating device for vehicles to obtain a level ride platform is admittedly old (Comstock, Vol. III, pp. 272-273). Such linkages are found in the cited prior art patents to Richards and Ives (Gabriel, Vol. III, p. 639) and most of the prior art patents in Exhibits C and D (defendant's prior art patents) starting with the Shadbolt patent which issued in 1896. The Lugash '227 patented combination is constructed and operates in the same way as old parallelogram arm loading devices when used for loading or unloading a vehicle (Gabriel, Vol. III, p. 624).

The "folding" of the platform, represented as being novel to the Patent Office, is found in the non-cited Narvestad, Peters and Jester patents. One need only be aware of the teachings of any of Narvestad, Peters or Jester to pivot the platform of Novotney '403 back over the lifting arms to fold it away.

> "All you have to do is see that teaching (Narvestad, Peters or Jester) and swing this platform 9 of Novotney '403 over and on top of the arm 7." (Gabriel, Vol. III, p. 701).
>
> "Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of the shank, would immediately

see that the things to do was what Graham did, *i.e., invert the shank and the hinge plate.*" (Emphasis added).

Graham v. John Deere Company of Kansas City, supra, 86 S. Ct. at 697.

It is obvious that the power means cylinder F of Novotney '403 (and the powered cable 16 of Narvestad) can be employed to raise the lifting arms whether the platform is extended rearwardly or pivoted back over the lifting arms. The natural, expected and unsurprising thing is to manually pivot the lowered platform over the lifting arms in Novotney '403 and then operate the power means until the platform and lifting arms are raised up under the vehicle bed in view of the teachings of Narvestad, Peters or Jester.

"This case is wanting of any unusual or surprising consequences from the unification of the elements here concerned. . . ."

A. & P. Tea Co. v. Supermarket Corp., 340 U.S. 147.

The Constitutional standard of patentability required by this Court, and as imposed thereon by *A. & P. Tea Co. v. Supermarket Corp.,* 340 U.S. 147 (1950), remains unchanged by the recent Supreme Court decisions.

"While the clear language of §103 places emphasis on an inquiry into obviousness, the general level of innovation necessary to sustain patentability remains the same."

* * *

"Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system, which by Constitu-

> tional command must 'promote the progress of . . . useful arts.' This is the standard expressed in the Constitution and it may not be ignored. And it is in this light that patent 'validity requires reference to a standard written into the Constitution'. A. & P. Tea Co. v. Supermarket Corp., supra at 154."
>
> *Graham v. John Deere Company of Kansas City, supra,* 86 S. Ct. at 686-687 and 688.

This Court has consistently applied the Constitutional standard:

> "Thus, the statute prescribed, as a condition of patentability, that what has been accomplished must be such that it would not have been obvious to a hypothetical person skilled in all that could have been known, at the pertinent time, in the field to which the invention relates.
>
> "It follows that though a device may be new and useful, it is not patentable if it consists of no more than a combination of ideas which are drawn from the existing fund of public knowledge, and which produces results that would be expected by one skilled in the art.
>
> *Griffith Rubber Mills & Hoffar,* 313 F. 2d 1, 3 (9th Cir., 1963).

Lugash '227 does not add to the sum of useful knowledge and fails to meet the standard expressed in the Constitution and referred to in *A. & P. Tea Co. v. Supermarket Corp., supra* at 154.

OLD ELEMENTS IN AN OLD COMBINATION ARE NOT PATENTABLE.

It must be abundantly clear by this time that the evidence establishes that each and every element of the Lugash claims is old and that the combination of elements is old.

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge."
>
> *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147 at 152.

> "The mere aggregation of a number of old parts or elements to which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."
>
> *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545 at 549.

The operative function of the Lugash platform is to support loads being moved between the ground and the truck bed levels, **the same function of all loading platforms in the prior art.** The hinged connections between the platform and the platform support member (50 in '227) of Lugash perform the same function that they always have, to merely pivotally mount the platform to the support member.

The lifting arms of the prior art Narvestad and Novotney '403 patents are power operated to function to raise and lower their loader support members (and connected platforms) during loading and unloading as

in Lugash. It is obvious that the power means of both Narvestad and Novotney '403 can be employed to raise the lifting arms and support member 24 after the loader platform has been manually inverted at ground level just as in Lugash.

All power operated lifting arms, having a connecting member to which a platform is hinged or pivoted, **will perform their normal and expected function to lift** the platform whether it is **empty or loaded or** whether the platform is **hinged into one position or another.** Would it be patentable invention to claim the same old combination of elements and state that you can raise the platform for purpose of amusement? Would this give rise to a new mode of cooperation of these old elements? Of course not, but Findings of Fact 22 and 23 **erroneously** attribute "two distinct modes of cooperation", one for load bearing purpose and one for storing purpose. Why not a third mode for purpose of amusement?

The trial court erred as a matter of fact [Finds. of Fact 7, 8 and 24] in finding a new combination of admittedly old elements in Lugash '227 where the same combination of old elements is found the prior art loaders, such as in Novotney '403. **The trial court erred as a matter of law** [Concls. of Law B and C] in not requiring this combination of admittedly old elements [Find. of Fact 8] to perform some new, unusual, surprising or unexpected function in the combination than they did not perform out of it, as required by *Lincoln Engineering Co. v. Stewart-Warner Corp., supra,* and *United States v. Adams, supra.*

UNCONTRADICTED TESTIMONY ESTABLISHES OBVIOUSNESS.

The **only** persons skilled in the art to testify as to the obviousness of the teachings of the state of the art as of 1957, when Lugash purportedly made his invention, are Messrs. Vogel and Gabriel who found the entire '227 combination claimed in the prior existing fund of public knowledge. The testimony is clear and definite and appears in Volume III, pages 462-463, 485-486, 699-701, 718-724.

Plaintiffs never cross-examined Messrs. Vogel or Gabriel as to the obvious teachings of the combined references relied upon by defendant, **never presented rebuttal expert testimony** nor argument as to why these combinations could not be made, nor presented any evidence which would show any distinguishing features between the combined state of the art and the combinations of elements claimed in the Lugash '227 patent.

Plaintiffs' counsel never asked his witness, Mr. Comstock, whether in his opinion Lugash '227 would, or would not, be obvious to one skilled in the art in view of the combined teachings, or state, of the art. It must be assumed that plaintiffs' patent expert, Mr. Comstock, was not examined by plaintiffs upon the combinations of references relied upon by defendant because his testimony thereon would not have been favorable to plaintiffs' position.

Plaintiffs' counsel carefully refrained from asking his expert whether the Lugash '227 patent would be obvious in view of the combination of a first reference teaching a power-operated parallelogram linkage system loader (such as Novotney '403 and Wood '135;

or Richards and Ives of the cited prior art) and any of the Narvestad, Peters or Jester references which disclose the folding up concept. Mr. Comstock's "résumé of testimony" (Vol. I, pp. 188-219) filed prior to the trial does not deal with any combination of references or make any statements as to the obviousness or non-obviousness of the Lugash '227 patent over the state of the art.

It can only be assumed from the foregoing that the plaintiffs' patent expert was unwilling to testify that the Lugash '227 claimed subject matter is non-obvious over the state of the art.

THE TRIAL COURT ERRED IN IGNORING THE OBVIOUSNESS OF LUGASH '227 AS ESTABLISHED BY EXPERT TESTIMONY.

The Supreme Court has stated, and recently repeated in *Graham v. John Deere Company of Kansas City, supra,* that the judiciary

> "Is most ill-fitted to discharge the technological duties cast upon it by patent legislation."
>
> *Marconi Wireless Co. v. United States,* 320 U.S. 1, 60 (1943).

The trial court **initially considered Lugash '227 to be invalid** over the state of the art established through defendant's technically skilled experts, Vogel and Gabriel (Vol. III, pp. 902-905). The trial court **subsequently substituted its opinion for that of the experts** in finding Lugash '227 non-obvious over the art. But, the trial court is not technically expert in the art.

The trial court committed reversible error in rejecting the experts' opinions on the obviousness of Lugash

'227, and in effect, not deciding the issue but rather concluding validity on inferences and secondary, make-weight grounds.

SECONDARY TESTS DO NOT PREVAIL WHERE STATUTORY REQUIREMENTS OF PATENTABILITY ARE NOT MET.

The Supreme Court recognized in the *Graham* case, *supra,* in discussing the Cook Chemical patent that the evidence disclosed that "a serious problem" had existed for many years in developing sprayers that could be integrated with the containers and that the Scoggin's device "was well-received and soon became widely used" (*Graham v. John Deere Company of Kansas City, supra,* 86 S. Ct. 2 at 699). Cook Chemical's expert testified it was the first "commercially successful, inexpensive, integrated shipping closure pump unit . . ." and it was urged that the long-felt need in the industry for the device, the inability of others to produce it and its commercial success all evidenced the non-obvious nature of the device at the time it was developed. The trial and appellate courts had agreed.

But the statutory prerequisites of novelty, utility and non-obviousness are paramount: The Supreme Court correctly looked past the "inferences" and "subtests" and found:

> "However, these factors do not, in the circumstances of this case, tip the scales of patentability. The Scoggin invention, as limited by the Patent Office and accepted by Scoggin, rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art. At the latest, those differences were rendered apparent

in 1953, by the appearance of the Livingstone patent, and unsuccessful attempts to reach a solution to the problems confronting Scoggin made before that time became wholly irrelevant. It is also irrelevant that no one apparently chose to avail themselves of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search—a prudent and nowadays common preliminary to well-organized research. Mast Foos & Co. v. Stover Mfg. Co., 117 U.S. 485 (1900). To us, the limited claims of the Scoggin patent are clearly evident from the prior art as it stood at the time of the invention."

Graham v. John Deere Company of Kansas City, supra, 86 S. Ct. at 703.

This Court should similarly look beyond the alleged commercial success and other "sub-tests" relied so heavily upon by the trial court below and look at the "technical facts", as in the past.

"Evidence of commercial success cannot overcome clear lack of novelty and invention."

Pevely Dairy Co. v. Borden Printing Co., 123 F. 2d 17 (9th Cir.).

Also

Stauffer v. Slenderella Systems of Calif., 254 F. 2d 127 (9th Cir.).

The trial court initially considered the Lugash '227 patent invalid upon defendant's showing of the state of the prior art. The prior art is exactingly complete in teaching every alleged novel aspect of Lugash '227. The trial court erred in deciding this case by sub-tests rather than the technical state of the art.

The trial court erred in stressing in its findings commercial success; unproved lack of success of prior art devices, demand and need, purported savings of time and money and similar make-weights [Finds. of Fact 9, 19, 24, 26 and 28].

The fact remains that there is no patentable invention defined in the Lugash '227 patent claims that fulfills statutory requirements. This Court must conclude that Lugash '227 adds nothing to the sum of knowledge, is merely an obvious combination of already known ideas in the art and is invalid for failure to meet the Constitutional standard of patentability referred to in *A. & P. Tea Co. v. Supermarket Corp., supra* and *Graham v. John Deere Company of Kansas City, supra.*

LUGASH '227 IS A STEP BACKWARD IN THE ART.

Plaintiffs' device, as represented to the trial court, not only does not produce new, unexpected or surprising results but has lost the advantages of some old results. The early Ducondu '473 patent [Ex. D] discloses a platform that can be used as a tailgate, load elevating platform and be swung down under the truck when not in use (Gabriel, Vol. III, pp. 626-628) to allow dock loading. Lugash has lost the tailgate function of the loading platform old in Ducondu '473 (Gabriel, Vol. III, p. 649).

Plaintiffs' own witnesses admitted the failure of the Lugash device to serve as a tailgate as well as fold out-of-the-way, as in the prior Anthony "Drop-Leaf" lift gate of Exhibit AD (Massman, Vol. III, p. 38). When the lift gate of the Anthony device of Exhibit AD is

folded down to its out-of-the-way position beneath the vehicle, it can be backed up against a loading dock. No new result or function is attained by Lugash '227 not obtained in this prior Anthony "Drop-Leaf" lift gate of Exhibit AD (Goodman, Vol. III, p. 76; Vogel, Vol. III, p. 466).

Messrs. Massman and Goodman even admitted that it **would be an advantage** to have a load elevator which could be used as a tailgate, like Exhibit AD, in addition to being folded to an out-of-the-way position beneath the vehicle (Massman, Vol. III, pp. 39-40; Goodman, Vol. III, p. 78).

The fact is that **the purported folding-over of the platform* is useless.** Plaintiffs' witness Massman testified:

> "Q. Now, when the platform in the Tuk-A-Way device is folded under the truck, what function does it have? * * * A. It doesn't have any when it is underneath the truck." (Vol. III, p. 41).

Actually, when the platform of plaintiffs' device is in the folded-up position, **the operator has to put additional, separate gates** on the back of his truck to keep articles from falling off.

> "Q. Is it essential to use these gates on the back of your trucks when you use the Tuk-A-Way loading system? A. Yes. We will not rent a truck out without these gates on there." (Grasse, Vol. III, p. 62).

Therefore the Lugash '227 device lifts loads **in exactly the same manner** as all prior lifting platforms, by

---

*Actual folding and lifting while in folded position is not required by the claims of Lugash '227.

the use of **the same elements** in the **same old relationship.** Prior loading platforms lifted loads and in addition were capable of acting as tail gates; when you use the Lugash device, you now have to put up separate tail gates. Is this a patentable advance, or is it a step backward?

DEFENDANT CANNOT INFRINGE BY USING WHAT IS IN THE PUBLIC DOMAIN.

There are six basic reasons why defendant does not infringe:

1. You cannot infringe an invalid patent.

International Carbonic Engineering Co. v. Natural Carbonic Products Inc., 158 F. 2d 285 (9th Cir.).

2. What is not claimed by the Lugash claims has been dedicated to the public and can be freely used.

"The public has the undoubted right to use * * * what is not specifically claimed in a patent."

Mahn v. Harwood, 112 U.S. 354, 361.

3. What is in the public domain can be freely used.

United States v. Dubilcre Condenser Corp., 289 U.S. 178 at 187.

4. One cannot be deprived of exercising normal skills and making obvious modifications to what is in the public domain.

"However, the public is entitled to benefit, without granting special concessions, from such advances as normally flow from the application of the

ordinary skills of one in the trade to the existing fund of public knowledge."

Griffith Rubber Mills v. Hoffar, 313 F. 2d 1, 3 (9th Cir., 1963).

5. The claims of Lugash '227 require a construction in which the folded platform rests on a stop which is part of the linkage. **This is not done by defendant.**

6. The Lugash claims require a parallel linkage which maintains the platform level during lifting. This is old *per se.* Defendant's lifts employ ramping gate links [Exs. AE and AL] and could not possibly infringe.

The evidence shows that the elements of defendant's loaders were designed prior to Lugash '227 and specification sheets showing the construction of defendant's early EB-1200 loader were distributed in June and July of 1957 [Exs. N, O, S, Vol. III, p. 425; Ex. T, Vol. III, p. 427]. This EB-1000 loader which was renamed "EB-1200" was a design which evolved out of defendant's prior knowledge and experience (Vol. III, p. 423).

In 1960, defendants' president, Mr. Vogel, made a few changes of degree only. He modified the loading platform [Exs. R and AQ] so that it would pivot back against the hydraulic cylinder. Pivoting or folding of a loading platform more than 90° was a concept that was part of the prior art which belonged to the public. This modification of the older model was "a simple matter", "not major in character," and "did not require retooling on the part of defendant" [Find. of Fact 13, Vol. I, pp. 665-666]. Certainly these changes were not inventive for defendant; as a member of the public,

he had the right to utilize what was in the prior art and to exercise his normal skill.

It would have been obvious, in view of Narvestad, to the "hypothetical person skilled in all that could have been known, at the pertinent time," (*Griffith Rubber Mills v. Hoffar, supra*) to pivot or hinge the platform of the Venco EB-1000, EB-1200 or EB-1500 to place the platform in an out-of-the-way position as actually done by defendant. Mr. Vogel testified as one skilled in the art that it would have been obvious to him how he could apply the Narvestad teachings to his early design EB-1000 loader:

> "Q. Now, if you had the disclosure of the Narvestad patent before you in—let us say in 1956, at the time you were aware of the various Anthony and Daybrook loading apparatuses for some two years after the Narvestad patent had issued, would it have been obvious to you how you could position the EB-1000 hydraulic loader platform you designed in early 1957 in an out-of-the-way position when not in use, you didn't want it to be used as a tailgate, from this Narvestad patent? A. Yes, it would be necessary to merely pivot it over 180 degrees or so to the position as shown in the Narvestad, in Fig. 7, in the Narvestad." (Vogel, Vol. III, p. 462).

Defendant's early EB-1000 and EB-1200 loaders are of the same construction as the heavier EB-1500FL construction charged to be infringements here, with the exception of the folding of the platform. Defendant's EB-1500FL loader of plaintiffs' Exhibit 4, found to infringe, differs from the prior non-folding EB-1500 loader of Exhibit X only in the hinging and size of the

platform and the provision of a body spacer on the rear end of the truck **(a non-claimed element)** (Vogel, Vol. III, pp. 442-445). The photographs for both exhibits were made of the same truck with merely the platforms replaced. The platform of Exhibit 4 is merely smaller to fold under the truck and does not have an inner flange which would abut the lifting arms. This minor change in degree of size and degree of pivoting beyond the verticial position is an obvious, non-inventive modification in view of the disclosures of Narvestad, Peters and Jester (Vogel, Vol. III, p. 448).

All of defendant's acts are therefore covered by items 1 to 4 of the reasons why defendant, as a member of the public, does not infringe. The remaining reasons why defendant does not infringe are discussed under the next heading.

LUGASH '227 CONSTRUCTION IS NOT FOUND IN DEFENDANT'S "FOLDA-LIFT" LOADERS.

Your Honors will note by examining Exhibit AM-1 that claim 1 of Lugash calls for

> "Said parallel rule linkage systems **include stop means against which** said platform may be swung about said hinged mounting to a position overlying and parallel to said linkage systems."

In claim 8, it is stated that the platform is permitted to be swung "into superposed position **on said linkage** systems".

Plaintiffs' witness, Mr. Comstock, admitted that the Lugash patent places the lifting arms at the outer sides of the platform to allow the platform to fold onto and

rest on a cross member 56 which is part of the linkage (Vol. III, pp. 207, 208 and 212-213).

Defendant's "Folda-Lift" loaders do not place the lifting arms at the platform sides and when the platform is folded, it **does not** lie on a linkage or any member which is a part of the linkage. The evidence and exhibits clearly show that defendant's platform, when folded, lies on the power cylinder. Therefore, defendant **does not** use the construction to which the Lugash claims are directed. The Lugash claims are limited to a specific relationship of the folded parts (if and when they are folded), but defendant does not employ such relationship.

It is well settled in this circuit, as in all other circuits, that plaintiffs must establish infringement by showing the accused device not only meets the terms of the patent claims, but also employs the same cooperation of elements as the patented device.

> "The mere fact that the accused article performs the same function and achieves the same result as the patented article does not necessarily establish infringement unless it can be found that this is accomplished in substantially the same way and, where, in this case, the art is fairly crowded and the main elements of the patent are found or indicated in the prior art, this issue should be determined narrowly, rather than liberally."
>
> *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82 (9th Cir., 1963).

The Lugash claims are limited to a specific relationship: **defendant does not employ such relationship.** Moreover, the trial court erred in finding that all

models of defendant's "Folda-Lift" loaders infringe Lugash '227 because plaintiffs' own witnesses stated that one of the advantages of the Lugash '227 construction is that it maintained the platform level or horizontal while lifting a load and this was supposed to be an advantage over the prior Anthony and Daybrook ramping-type loaders (Massman, Vol. III, pp. 46-47; Grasse, Vol. III, pp. 60-61). This so-called "level ride" was attributed to the parallel rule linkage system which is mentioned in each of the claims of Lugash '227. The trial court found that this level ride is a characteristic of the Lugash device [Finds. of Fact 6 and 22] and thereby allegedly distinguished from certain prior patents. The fact remains that **parallel linkage systems are old** as clearly shown by the Novotney patent and there certainly is no invention in substituting one type of lifting arm for another. But the fact also remains that defendant makes "Folda-Lift" loaders which employ ramping gate links [Exs. AE and AL] as well as non-ramping gate links and certainly the **ramping gate links do not produce the so-called "level ride"** platform and could not possibly be infringements.

Fundamentally the patent is invalid and could not be infringed; the limitations in the claims which also preclude infringement are being called to your Honor's attention for the purpose of emphasizing the errors compounded by the trial court.

EVIDENCE ESTABLISHES THAT PLAINTIFFS ARE GUILTY OF FALSE MARKING.

The trial court found [Find. of Fact 37] that

> "Certain H-23 models of plaintiffs Tuk-a-Way' loader did not employ the unitary construction required by the claims of patent '196, yet carried the numbers of both patents."

The evidence on this point was given by plaintiffs' witness Lugash and was clear-cut.

> "Q. On the H-23 models that you sell, do you attach to it a nameplate such as I hold in my hand, Exh. 30? A. Yes we do.
>
> Q. That nameplate has both patent numbers on it involved in the suit, the '227 patent and the '196 patent. Is that right? A. Yes.
>
> Q. And did you, your company, intend to indicate to the public that the '196 patent protected and covered the Model H-23? Was that your intention? A. Our intent was to show that patents were issued to the company covering the Tuk-A-Way units.
>
> Q. And covering specifically the H-23 Model, that is what I'm talking about. A. Yes.
>
> * * *
>
> "The Court: Did you arrange for the making of these decals on these plates with the patent numbers on them?
>
> The Witness: Yes, I did.
>
> * * *
>
> "The Court: Do you know why it went on there? Do you know what the intent was by putting this plate on Model H-23?

> The Witness: To publicize our patent numbers. We had been informed to show our patent numbers on the equipment and this is what we intended to do, show them." (Vol. III, pp. 305-307).

False marking is contra to 35 U.S.C. §292. Since false marking was clearly established the wrongful intent to deceive the public is presumed until the contrary appears.

> "The presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive."
>
> *Krieger v. Colby,* 106 F. Supp. 124 (D.C. S.D., Calif., 1952).

It may be noted that appellees' counsel represented the successful party in the *Krieger* case and are aware of this legal presumption.

The stated intent was to tell the public that the '196 patent covered the non-unitary models H-23. No evidence was presented by plaintiffs attempting to show that the mismarking was innocent, there was no evidence presented to show that the plaintiffs have discontinued the mismarking. Therefore the court's finding of innocent mismarking [Find. of Fact 38] is unsupported and contrary to the presumption of wrongful intent which was never rebutted.

It is submitted that Finding of Fact 38 is in error and is unsupported by the evidence. Conclusion of Law I is also in error.

CONCLUSION.

Lugash '227 has not added to the sum of useful knowledge in the load elevator art. It merely makes use of the existing fund of knowledge readily available to those skilled in the art who chose to avail themselves of the knowledge stored in the Patent Office record. The Novotney '403, Narvestad, Peters, Jester, Wood '135 and the other prior art patents found in Defendant's Exhibits C and D not considered by the Patent Office in issuing the Lugash '227 patent clearly demonstrate that each and every mechanical element of Lugash '227 is old. has been employed in the prior art in the same cooperative relationships to produce the same results and has become a part of the public domain freely available to all persons in this art. Lugash '227 and each of its claims in issue are invalid.

> "He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satified with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge."
>
> *Dow Chemical Co. v. Haliburton Oil Well Cementing Co.*, 324 U.S. 320, 328, 89 L. Ed. 973, 980, 64 U.S.P.Q. 412, 415 (1945).

The trial court's Conclusion of Law holding Lugash '227 patent valid, must be reversed, since that conclusion is not based upon facts which clearly advise this Court as to what was the unobvious, surprising and inventive result attained by the combination of old elements defined by the claims.

Similarly, the trial court's Conclusion that defendant infringed must be reversed, since the facts do not support such conclusion. It is not to the public interest to prevent the public from free, normal use of what is in the public domain.

Finally, the Conclusion that plaintiff was not guilty of mismarking should be reversed, since the evidence clearly establishes that the mismarking was purposeful and with the intent of impressing the public with non-existent patent protection.

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William Poms,
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of
Miketta, Glenny, Poms & Smith,
Attorneys for Appellant.

Certificate.

I certify that in connection with the preparation of this brief I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit and that, in my opinion, the foregoing brief is in full compliance with those rules.

GUY PORTER SMITH,

APPENDIX A.

Pertinent Sections of Title 35, U.S.C.

§101. "Inventions patentable

Whoever invents or discovers any **new** and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. * * *"

§102. "Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or **patented** or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was **patented** or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or * * *"

§103. "Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

subject matter as a whole would have been **obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *"

§112. "Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. * * *"

§292. "False Marking

* * * Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word 'patent' or any word or number importing that the same is patented, for the purpose of deceiving the public; or * * *

* * * shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States. July 19, 1952, c. 950, §1, 66 Stat. 814."

APPENDIX B.

Plaintiffs' Exhibits.

Exh.	Description	Page Reference In Record (Vol. III) Received In Evid.
1	Lugash patent in suit, No. 2,837,227	
2	Lugash patent in suit, No. 2,989,196	7
3	Assignment of patents in suit from Max J. Lugash to Maxon Industries, Inc.	8
4	"Folda-Lift" brochure of defendant	120
5	A one-fifth scale model of defendant's "Folda-Lift" device	131
5 A–D	Photos of Exh. 5 model	132
6	Plaintiffs' interrogatories (1 through 9 and Exh. A) and defendant's answers	8
7	Defendant's answers to plaintiffs' interrogatories 13, 19 and 20	8
8	Deposition of Milton C. Vogel	9
9	A "Folda-Lift" brochure of defendant	193
10	An advertisement of defendant's "Folda-Lift"	191
12	Defendant's drawing entitled "Installation Model 1500 'Folda-Lift' "	121
13	Defendant's drawing entitled "Double Folding Platform 1500 and 2000 DFL Venco 'Folda-Lift' "	193
15	Defendant's drawing entitled "Installation Power Platform Unfolding"	121
16	Defendant's drawing entitled "PTO Installation"	173
17	Page from defendant's "Folda-Lift" manual having schematic diagram of hydraulic system	173
18	A set of Polaroid photographs of defendant's "Folda-Lift" device	181
19	A set of photographs of defendant's "Folda-Lift" device with DFL platform	196
20	Chart of defendant's sales	198
21	Advertising pamphlets showing plaintiffs' "Tuk-A-Way"	302
22	Chart of sales of plaintiffs' "Tuk-A-Way" devices	293
27	Defendant's drawing No. 11772, Double Folding Platform	195
30	"Tuk-A-Way" nameplate	302
32	Toy Truck	47

Defendant's Exhibits.

Exh.	Description	Page Reference In Record (Vol. III) Received In Evid.
A	Certified copy of file history of Lugash Patent No. 2,837,227	623
B	Certified copy of file history of Lugash Patent No. 2,989,196	691
C	Defendant's Prior Art Exhibit Book	703
D	Defendant's Prior Art Exhibit Book	703
E–G	Brochure, Daybrook Power Gates	403
E–V	Brochure, "Tuk-A-Way" Electric Hydraulic Lift	490
F	Original drawing of Milton C. Vogel dated 12-23-47	360
G	Original drawing of Milton C. Vogel dated 12-23-47 and marked Fig. 2	360
H	Blueprint of drawings of Milton C. Vogel	361
I	Certified copy of Vogel patent application Serial No. 13,688 filed March 8, 1948 entitled "Truck Elevator"	369
J	Venco brochure entitled "Venco Electric Power Tailgate Loader" dated 4/56	378
K	Venco brochure "Model 30" tailgate loader	348
L	Venco brochure "Model 300" tailgate loader	378
M	Copy of Vogel Patent No. 2,820,554 entitled "Tail Gate Lift for a Vehicle"	384
N	Drawing No. 01080, The Ven Corp., entitled "Venco EB-1000" dated 1-21-57	420
O	Drawing No. 01092, The Ven Corp., entitled "EB-1000 Venco Loader" dated 2-12-57	420
P	Print 01121, The Ven Corp., entitled "EB-1000 Loader" dated 7-19-57	420
Q	Brochure "Model EB-1000" Venco Tailgate Loader	423
R	Drawing No. 01141, Santa Anita Mfg. Corp., entitled "Tail Gate Assembly EB-1200 Loader" dated 12-24-57	429
S	Brochure "EB Series Venco Loader" File L, dated 6-24-57	429
T	Brochure "EB-1200 Venco Loader" File L, dated 7-1-57	429
U	Drawing, The Ven Corp., entitled "Pivoted Arm Type Loader, Hydraulically Operated" dated 7-25-58	420

V	Venco brochure "Model EB-1500"	432
W	Venco brochure "Model EB-1500"	432
X	Tailgate Loader "Model EB-1500" form EB-15-6101	432
Y	Brochure, reprinted from Hildy's 1961 Ford Blue Book, Venco "A Lift for Every Job"	450
Z	Brochure, Venco "A Lift for Every Job" form TW-6210	450
AB	Brochure, "Galion Loadelevator Hydraulic End-Loaders" copyright 1955	389
AC	Brochure, "Anthony Lift Gate"	409
AD	Brochure, Anthony "Drop Leaf—Lift Gate"	76
AE	Drawing 01086, Santa Anita Mfg. Corp., entitled "Ramping Gate Link" dated 12-30-59	437
AF	Drawing 01104, The Ven Corp., entitled "Lower Arm" dated 9-15-59	437
AG	Drawing 01105-1, The Ven Corp., entitled "Upper Arms" dated 9-14-59	437
AH	Drawing 01081, The Ven Corp., entitled "Main Pivot Block" dated 7-27-59	437
AI	Drawing No. 11287, Santa Anita Mfg. Corp., entitled "Main Pivot Block" dated 12-30-59	440
AJ	Drawing No. 11327, Santa Anita Mfg. Corp., entitled "Gate Link Non-Ramping" dated 3-2-60	440
AK	Drawing No. 01266, Santa Anita Mfg. Corp., entitled "Upper Arm" dated 6-29-60	440
AL	Drawing No. 11286, Santa Anita Mfg. Corp., entitled "Ramping Gate Link" dated 12-30-59	440

AM	Claims	Prior Art	
AM-1	1, 2 & 4	Novotney '403	710
AM-2	8, 9 & 11	Novotney '403	713
AM-3	1	Narvestad	717
AM-4	8	Narvestad	718
AM-5	1, 2 & 4	Narvestad & Wood '135	722
AM-6	8, 9 & 11	Narvestad & Wood '135	724

AN		Claims	Prior Art	
	AN-1	1	Lugash '227, Claim 7	
		2	Wood '540	742
	AN-2	1	Novotney '403 & Messick	
		2	Messick	747
	AN 3	1	Novotney '403 & Wachter	
		2	Wood	753
	AN-4	4	Lugash '227, Claim 2 & Messick	753
	AN-5	4	Lugash '227, Claim 7 & Wood '540	753
	AN-6	4	Messick & Narvestad	753
	AN-7	6	Lugash '227, Claim 5 & Wood '540	753
	AN-8	6	Lugash '227, Claim 5 & Spitler	753
	AN-9	6	Messick	753
	AN-10	6	Wood '540	753
	AN-11	6	Vogel & Spitler	753
AO	AO-1	Shadbolt		629
	AO-2	Ducondu '011		629
	AO-3	Jester		703
	AO-4	Peters		703
	AO-5	Narvestad		691
	AO-6	Novotney '403		702
	AO-7	Messick, Sheet 1		727
	AO-8	Messick, Sheet 2		727
	AO-9	Messick, Sheet 3		727
AP	Drawing No. 11915, Santa Anita Mfg. Corp., Model 1500 FL Venco "Folda-Lift", dated 2-4-65			472
AQ	Drawing No. 11389, Santa Anita Mfg. Corp., entitled "Platform" dated 5-15-61			472
AR	Drawing No. 11292, Santa Anita Mfg. Corp., entitled "Hydraulic Cylinder" dated 1-15-60			472
AS	Sketches of Milton Vogel			465
AT	Watson "Hide-A-Gate" brochure			465
AW	"Answers to Defendant's Further Interrogatories 40-49" dated October 4, 1963			867
AY	"Answers to Defendant's Request for Admissions" Nos. 1-23 dated August 12, 1963			867

'22

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and vice versa.

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level of the truck

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when not in use.
lines 15-25].

'227 As

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cited art." [Pate
p. 24].

'2

"When not in
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"Q. Just to s
understand your
Way is there whe
when you don't
(Vol. III, p. 33)

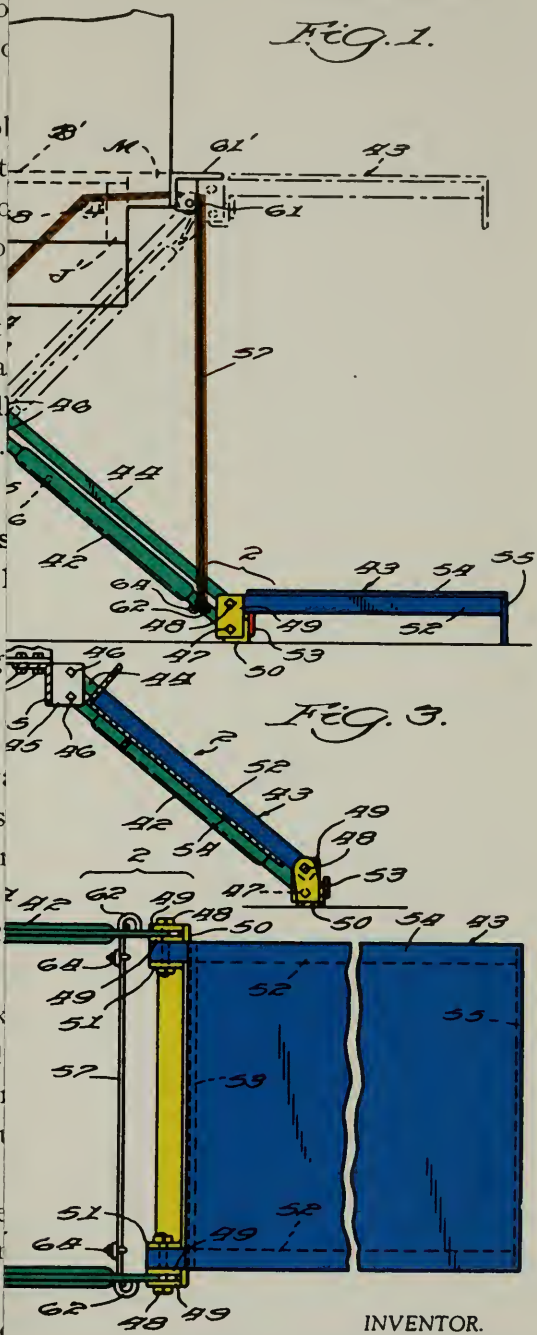
"It seemed fr
have stated that
and that is, it is t
you don't need it
man, Vol. III, pp.

J. LUGASH 2,837,227

TOR FOR MOTOR TRUCKS

2 Sheets-Sheet 1

Fig. 1.



AN		Claims	Prior Art	
	AN-1	1	Lugash '227, Claim 7	
		2	Wood '540	742
	AN-2	1	Novotney '403 & Messick	
		2	Messick	747
	AN 3	1	Novotney '403 & Wachter	
		2	Wood	753
	AN-4	4	Lugash '227, Claim 2 & Messick	753
	AN-5	4	Lugash '227, Claim 7 & Wood '540	753
	AN-6	4	Messick & Narvestad	753
	AN-7	6	Lugash '227, Claim 5 & Wood '540	753
	AN-8	6	Lugash '227, Claim 5 & Spitler	753
	AN-9	6	Messick	753
	AN-10	6	Wood '540	753
	AN-11	6	Vogel & Spitler	753
AO	AO-1	Shadbolt		629
	AO-2	Ducondu '011		629
	AO-3	Jester		703
	AO-4	Peters		703
	AO-5	Narvestad		691
	AO-6	Novotney '403		702
	AO-7	Messick, Sheet 1		727
	AO-8	Messick, Sheet 2		727
	AO-9	Messick, Sheet 3		727
AP	Drawing No. 11915, Santa Anita Mfg. Corp., Model 1500 FL Venco "Folda-Lift", dated 2-4-65			472
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AR	Drawing No. 11292, Santa Anita Mfg. Corp., entitled "Hydraulic Cylinder" dated 1-15-60			472
AS	Sketches of Milton Vogel			465
AT	Watson "Hide-A-Gate" brochure			465
AW	"Answers to Defendant's Further Interrogatories 40-49" dated October 4, 1963			867
AY	"Answers to Defendant's Request for Admissions" Nos. 1-23 dated August 12, 1963			867

'227 Objects.

"This invention relates to hoisting devices and more particularly to devices attachable to the rear end of a motor truck and operable to lift loads from ground level to level of the truck bed and vice versa.

The principal object of the invention is to provide a load elevating means which is attachable to the rear end of a truck frame and which is operable to lift or lower a load relative to the level of the truck bed.

Another object of the invention is to provide a device of the above character which may be folded up or collapsed beneath the truck bed when not in use." ['227 Patent, Ex. 1, Col. 1, lines 15-25].

'227 Asserted Novelty.

"New claims 11 through 14 are presented. These claims are all directed in more or less detail to the folding up aspect of the lifting device. This has proved to be the most valuable selling point and has been indicated as being patentable by the allowance of claims 4 and 10 and by the complete absence of this feature from the cited art." [Patent Office File History, Ex. A, p. 24].

'227 Results.

"When not in use, it is effectively concealed beneath the truck body and thus does not interfere with normal loading and unloading operations." (Col. 5, lines 22-24)

"Q. Just to summarize, Mr. Massman, do I understand your testimony to say that Tuk-A-Way is there when you need it, but it isn't there when you don't need it? A. That is correct." (Vol. III, p. 33)

"It seemed from what the other witnesses have stated that it would be the same for me, and that is, it is there when you need it and when you don't need it, it is not in the way." (Goodman, Vol. III, pp. 71-73)

June 3, 1958 M. J. LUGASH 2,837,227

LOAD ELEVATOR FOR MOTOR TRUCKS

Filed April 15, 1957 2 Sheets-Sheet 1

Fig. 1.

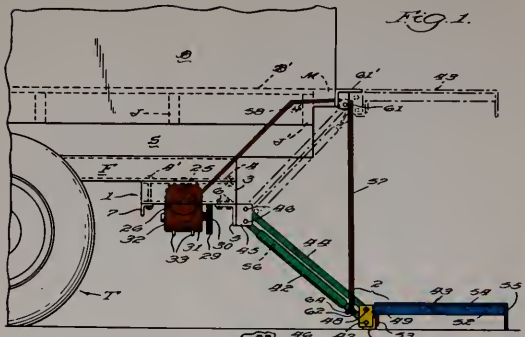


Fig. 3.

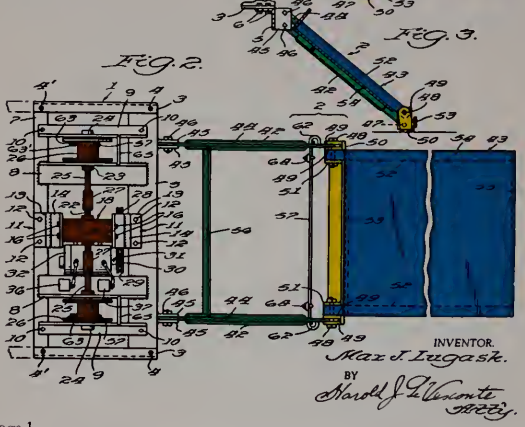


Fig. 2.

INVENTOR.
Max J. Lugash.
BY
Harold J. Levante
Atty.

AN		Claims	Prior Art	
	AN-1	1	Lugash '227, Claim 7	
		2	Wood '540	742
	AN-2	1	Novotney '403 & Messick	
		2	Messick	747
	AN 3	1	Novotney '403 & Wachter	
		2	Wood	753
	AN-4	4	Lugash '227, Claim 2 & Messick	753
	AN-5	4	Lugash '227, Claim 7 & Wood '540	753
	AN-6	4	Messick & Narvestad	753
	AN-7	6	Lugash '227, Claim 5 & Wood '540	753
	AN-8	6	Lugash '227, Claim 5 & Spitler	753
	AN-9	6	Messick	753
	AN-10	6	Wood '540	753
	AN-11	6	Vogel & Spitler	753
AO	AO-1	Shadbolt		629
	AO-2	Ducondu '011		629
	AO-3	Jester		703
	AO-4	Peters		703
	AO-5	Narvestad		691
	AO-6	Novotney '403		702
	AO-7	Messick, Sheet 1		727
	AO-8	Messick, Sheet 2		727
	AO-9	Messick, Sheet 3		727
AP	Drawing No. 11915, Santa Anita Mfg. Corp., Model 1500 FL Venco "Folda-Lift", dated 2-4-65			472
AQ	Drawing No. 11389, Santa Anita Mfg. Corp., entitled "Platform" dated 5-15-61			472
AR	Drawing No. 11292, Santa Anita Mfg. Corp., entitled "Hydraulic Cylinder" dated 1-15-60			472
AS	Sketches of Milton Vogel			465
AT	Watson "Hide-A-Gate" brochure			465
AW	"Answers to Defendant's Further Interrogatories 40-49" dated October 4, 1963			867
AY	"Answers to Defendant's Request for Admissions" Nos. 1-23 dated August 12, 1963			867

Narvestad Objects.

"This invention relates to loading apparatus for use on trucks and other goods transporting road vehicles and in particular relates to the class of loading apparatus embodying a load receiving support carried by a structure so articulated to the vehicle body that by a power or manually actuated driver the said structure can move the load receiving support into alignment with the floor of the vehicle and maintain it in such position during a loading or unloading operation, and also lower the support to a position close to the road or other surface on which the vehicle stands for the purpose of receiving or discharging a load at about road level." (Narvestad, Col. 1, lines 1-14)

"A still further object of the invention is to provide loading apparatus which is **collapsible or foldable** beneath the vehicle body **when out of use** and which, . . ." (Col. 1, lines 54-57)

Narvestad Result.

"When the apparatus is not in use it can be stowed away beneath the floor 3 by turning the platform upside down about the pivot 25 as shown in Figure 7 and pressing the rods 21 home in the tubes 20, the arms 29 folding close against the platform plate 26." (Col. 5, lines 63-69)

Narvestad states objects and produces results identical to and anticipating of Lugash '227. Its loader is also "there when you need it, but it isn't there when you don't need it."

June 8, 1954 E. NARVESTAD ET AL 2,680,529
LOADING APPARATUS FOR USE ON VEHICLES
Filed Aug. 31, 1951 2 Sheets-Sheet 2

Fig. 5.

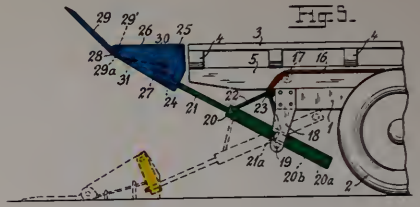


Fig. 6.

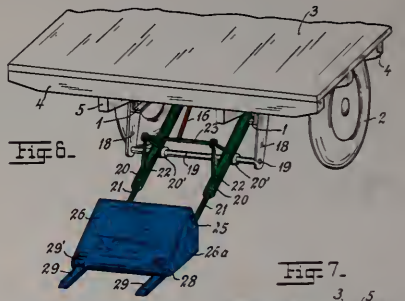
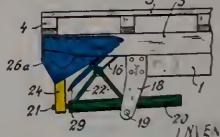


Fig. 7.



INVENTORS
ERLING NARVESTAD & ERLING JENSEN
By Kenelm Robinson
AGENTS

AN		Claims	Prior Art	
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	AN-2	1	Novotney '403 & Messick	
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March 19, 1940. F. A. NOVOTNEY 2,194,403
END GATE LOADER
Filed June 19, 1939 2 Sheets-Sheet 2

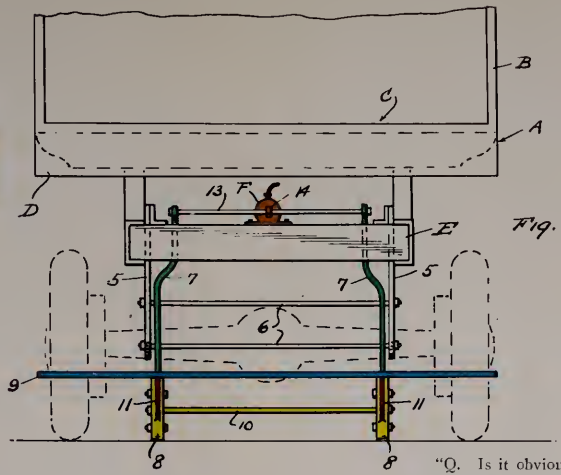
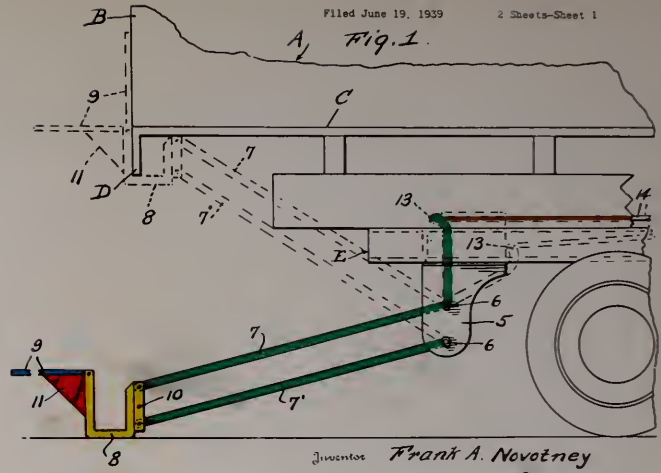


Fig. 2.

Inventor
Frank A. Novotney
By L. B. James
Attorney

March 19, 1940. F A NOVOTNEY 2,194,403
END GATE LOADER
Filed June 19, 1939 2 Sheets-Sheet 1



Inventor Frank A. Novotney
By L. B. James
Attorney

Novotney '403 in View of Narvestad.

"Q. Now, do you find any teaching in the Narvestad, Jester or Peters patent which would make it obvious to you to move the Novotney platform 9 into an inverted position on the lifting arm 7 and place the platform in an out-of-the-way position beneath the vehicle bed? A. Certainly, the teaching in Narvestad, in Peters and in Jester, all three of those teach a platform being swung up and over so as to be on the linkage and it would be then under the truck bed. **All you have to do is see that teaching and swing this platform 9 of Novotney '403 over and on top of the arm 7.**" (Gabriel, Vol. III, p. 701)

"Q. Is it obvious to you from the construction shown in the drawings of this Novotney patent that the platform 9 could be folded back until it hit the lifting arm 7? A. Yes.

Q. And further, if it were suggested to you to fold or collapse the platform under the vehicle bed, as in the Narvestad patent, 2,680,529, that we discussed previously, would that make it further obvious to you, you can fold or collapse the platform 9 of Novotney over the arm 7 when in the lowered position of Fig. 1, with no further modifications of any kind to the Novotney construction, so that the arm 7 would then be raised and the platform 9 would be positioned in an inverted position beneath the vehicle bed?

* * *

The Witness: Yes." (Vogel, Vol. III. pp. 486-487)

This testimony of defendant's technical experts on the combined teachings of Narvestad and Novotney stands uncontradicted in the record.

The Trial Court found that the Novotney platform would fold:

"It is mechanically *possible* to invert the platform in the Novotney over the parallel linkage system in that device . . ." (Memorandum Opinion. Vol. III, p. 563)

". . . it is mechanically *possible* to invert the platform in the said Novotney device . . ." (Find. of Fact, 16, Vol. III, p. 666).